



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/082,017 | 02/25/2002 | Scott A. Ciarrocca | G-4 | 4438 |

21394 7590 07/18/2003
ARTHROCARE CORPORATION
680 VAQUEROS AVENUE
SUNNYVALE, CA 94085-3523

EXAMINER

COHEN, LEE'S

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3739

DATE MAILED: 07/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/082,017

Applicant(s)

CIARROCCA ET AL.

Examiner

Lee S. Cohen

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-124 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 80-87, 92-96, 99-104, 106-110, 113-116 and 122 is/are allowed.
- 6) ☒ Claim(s) 1-79, 88-91, 97, 98, 105, 111, 112, 117-121, 123 and 124 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

In light of the indicated allowability of generic claims *infra*, the election of species requirement previously set forth is hereby withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-79, 88-91, 97, 98, 105, 111, 112, 117-121, 123, and 124 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 – “the probe distal end” lacks antecedent basis. Claim 3 – the push rod should be associated with the movable return electrode. Claims 24 and 25 – “the movable return electrode distal end” lacks antecedent basis. Claim 51 – “the return electrode” fails to accurately reference a particular return electrode. Claim 60 – “the shaft” lacks antecedent basis. Claim 62 – “the shaft” lacks antecedent basis. Claim 66 – “the distal end of the second spacer” lacks antecedent basis. Claim 88 – “the push rod distal end” lacks antecedent basis. Claim 91 – reference to “the active electrode” *per se* fails to accurately reference its antecedent. Claims 97 and 98 – reference to “the active electrode” *per se* fails to accurately reference its antecedent. Claim 105 – “the shaft distal end” and “the target site” lack antecedent basis. Claim 111 - “the probe distal end” lacks antecedent basis and step “f)” is vague absent a step “e)” in claim 107. Claim 112 - “the probe distal end” lacks antecedent basis and step “g)” is vague absent a step “e)” in claim 107. Claim 117 - steps “i)” and “j)” are vague absent a step “e)” in claim 107. Claims 123 and 124 – reference to “the active electrode” *per se* fails to accurately reference its antecedent.

Art Unit: 3739

Allowable Subject Matter

Claims 80-87, 92-96, 99-104, 106-110, 113-116, and 122 are allowed.

Claims 1-79, 88-91, 97, 98, 105, 111, 112, 117-121, 123, and 124 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Priority

Applicant's priority claims to application nos. 09/041,934 and 09/162,117 appear to be improper. Neither application has a common inventor. In addition, 09/162,117 was not copending with the instant application.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references disclose electrosurgical apparatus with movable electrodes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee S. Cohen whose telephone number is 703-308-2998. The examiner can normally be reached on Monday-Friday, 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 703-308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Application/Control Number: 10/082,017

Page 4

Art Unit: 3739

A handwritten signature in black ink, appearing to read 'Lee S. Cohen', with a long horizontal flourish extending to the right.

Lee S. Cohen
Primary Examiner
Art Unit 3739

LSC

July 10, 2003